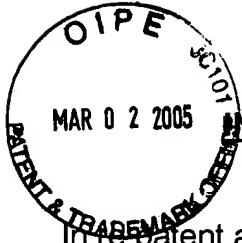


AP/2142
/JW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

) Date: February 25, 2005

Ronald P. Sansone, et al.

) Attorney Docket No.: F-236

Serial No.: 09/818,721

) Customer No.: 00919

Filed: March 27, 2001

) Group Art Unit: 2142

Confirmation No.: 1333

) Examiner: Thong H. Vu

Title: **SENDER ELECTED MESSAGING SERVICES**

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on January 14, 2005.

Pursuant to 37 CFR 1.17(c), the fee for filing the Appeal Brief is \$500.00.

Please charge Deposit Account No. **16-1885** in the amount of \$500.00 to cover the above fees.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,



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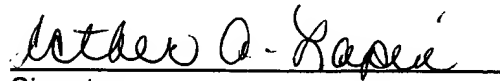
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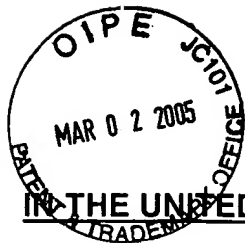
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Name of Rep.


Signature

February 28, 2005
Date



In re patent application of:

Ronald P. Sansone, et al

Serial No.: 09/818,721

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) Group Art Unit: 2142

) Examiner: Thong H. Vu

) Date: February 28, 2005

) Confirmation No. 1333

Title: **SENDER ELECTED MESSAGING SERVICES**

APPELLANTS' BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on January 14, 2005.

This brief is transmitted in triplicate.

03/03/2005 AWONDAF1 00000067 161885 09818721

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This brief contains these items under the following headings and in the order set forth below:

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- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
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- IX. CLAIMS APPENDIX

I. REAL PARTY IN INTEREST

Pitney Bowes Inc. is the real party in interest by way of assignment from the Appellant.

II. RELATED APPEALS AND INTERFERENCES

A. An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/818,480 entitled "Recipient Elected Messaging Services That Is Transported In Trays Or Tubs" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

B. An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/818,792 entitled "Recipient Elected Messaging Services" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

C. An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/817,998 entitled "Messaging Services For The Visually Impaired" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-6 are in the application.

Claims 1-6 are rejected.

Claims 1-6 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment subsequent to the October 18, 2004, Final Rejection was filed on December 15, 2004. This Amendment was entered.

V. SUMMARY OF INVENTION

A. BACKGROUND

Ever since the numeric codification of streets and buildings received general acceptance, an individual's name and the individual's household postal address have

been linked. The sender of a letter or package would deliver a letter or package to the post that had the correct recipient postal address, and the post would deliver the letter or package to the numeric street address of the recipient of the letter or package. A correct recipient postal address for the delivery of the letter or package to the recipient included the name of the recipient; the street address of the recipient; the city and state of the recipient; and the zip code of the recipient. Thus, the correct recipient postal address is usually the actual location of the recipient.

Sometimes senders of letters, flats and packages like to know where the recipient letters and packages are in the delivery stream. For instance, if someone is shipping goods, bills, documents, dated material, etc., to different areas, that sender may want to know if there are any problems delivering the letters, flats and/or packages. Someone may also want to speed up or slow down the delivery of a letter, flat or package that is in the delivery stream. The sender may want to redirect the letter, flat and/or package, because the recipient wants the letter, flat and/or package sent to a different address. The sender may want the letter, flat and/or package back because the recipient does not pay its bills, or the recipient is bankrupt. The sender may also want to make sure that the recipient can not divert the sending of the letter, flat and/or package to a different address; e.g., the letter, flat and/or package may contain legal documents.

B. APPELLANTS' CLAIMED INVENTION

1. Claim 1, the only independent claim in this patent application, relates to a method that enables a recipient to inform a carrier of the manner in which the recipient would like their mail delivered. More particularly, claim 1 includes the following steps: depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address; capturing the name and physical address of the recipient and the sender from the physical mail; translating the name and physical address of the recipient into an e-mail address; notifying the recipient of the availability of the deposited physical mail; notifying the carrier of the manner in which the recipient would like the physical mail delivered; notifying the carrier that the sender does not elect the deposited physical mail to be diverted; and delivering physical mail to the recipient

in the manner specified by the recipient to the carrier, if the sender elects to permit the recipient to divert the physical mail.

Appellants' invention is a method that enables a recipient to receive notification of the letters, flats and/or packages (mail) that the recipient is going to receive prior to the delivery of the mail. The recipient is then able to inform a post or courier e.g., Federal Express®, Airborne, ® United Parcel Service®, DHL®, etc., of the manner in which the recipient would like the mail delivered if it is acceptable to the sender. The post and courier hereinafter will be referred to as "carrier". For instance, the recipient may want the mail physically delivered to their house faster or slower, or the mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the carrier open the physical mail and have the carrier e-mail or fax the contents of the mailpiece to the recipient and/or parties designated by the recipient. The foregoing recipient elections will only be allowable if the sender elects to permit the recipient to divert the mail.

Appellants' claimed invention is shown in Fig. 2 and described in line 4 of page 6 to line 5 of page 11 of Appellants' Patent Application. A copy Fig. 2 appears next to this page.

Fig. 2 is a drawing showing how this invention may be used by a post in the processing of letters. Letter mail that is deposited in trays 6 and delivered to the post is read by multiple optical character reader ("MLOCR") 23. Collection letter mail may be: metered letter mail that is produced at a mailer site 7 or a sender household 8 by a postage meter or a personal computer meter; stamped mail; or permit mail. Collection letter mail is placed in collection mail input 21, e.g., mail boxes or delivered to the United States Postal Service, unsorted. Collection letter mail is sent to advanced facer canceller ("AFCS") 22. AFCS 22 first faces the letter mail. Then AFCS 22 electronically identifies and separates prebarcoded mail, handwritten addresses and machine-imprinted address pieces for faster processing through automation. Letter mail that 22 determines is optical character readable is sent to multi-line optical character reader/code printer ("MLOCR") 23. MLOCR 23 reads the entire address on the letter mail; sprays a bar code on the mail; and then sorts the mail. Letter mail that is able to

be scanned and sorted by MLOCR 23 is sent to bar code sorter/code printer ("BCS") 24. Letter mail that the mailer has prebarcoded and contains a facing identification mark is sent to BCS 24.

Trayed mail 82 (mail in which the sender is entitled to discounts) that is produced at a major mailer site 90 (Fig. 5) is sent to a delivery bar code sorter/code printer ("DBCS") 25 or a carrier sequence bar code sorter/code printer ("CSBCS") 26. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27. Letter mail that AFCS 22 determines is not optical character readable is sent to bar code sorter/code printer 28. Letter mail that AFCS 22 obtains electronic images from and letter mail that MLOCR 23 obtains electronic images from transfers the electronic images to remote bar code system ("RBCS") 32. RBCS 32 matches the looked-up zip code for the letter mailpieces from AFCS 22 and merges them. RBCS 32 electronically transmits the bar code information to BCS 28 where the bar code information is sprayed on the mailpieces. Letter mail that is able to be scanned and sorted by sorters 24 and 28 is sent to a delivery DBCS 25. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27, or hold the mail for recipient diversion for a specified period of time in divert mail options rerouting controller 62.

Letter mail that cannot be scanned and sorted by sorters 24 and 28 is sent to letter mail sort machine ("LSM") 29. Letter mail that can be sorted by LSM 29 is sent to postal hand casing 30. Postal hand casing 30 is the process in which the postal carrier sorts the letter mail in the order that the letter mail is going to be delivered by postal carrier 27. Letter mail that cannot be sorted by LSM 29 is sent to manual lookup/scan 31. Manual lookup/scans 31 attempts to classify the previously rejected mailpiece to redirect the mailpiece; declare the mailpiece dead; or manually re-code the mailpiece for redelivery. Then the mailpieces that have not been processed in manual lookup/scan 31 are sent to dead letters 33. In manual lookup/scan 31, an operator may determine the address of the recipient and produce a label to be placed on the letter mail. Then the letter mail would go to postal hand casing 30 where the mail is sorted in the order that the mail is going to be delivered by postal carrier 27.

Letter mail that cannot be faced and cancelled by AFCS 22 is sent to manual lookup/scan process 31. Manual lookup/scan 31 attempts to classify the previously rejected letter mailpiece to redirect the mailpiece; declare the mailpiece dead; or manually re-code the mailpiece for redelivery. Then the letter mail that manual lookup/scan 31 is able to classify is sent to postal carrier hand casing 30 before it is delivered by postal carrier 27.

Coded video system ("RBCS") 32 electronically transmits the bar code information that represents the destination of the letter mailpiece and the party to whom the mailpiece is to be delivered and the image of the face of the mailpiece to data center 34. The aforementioned scanners scan all of the information appearing on the face of the letter mail, e.g., the sender's name and address 12 (Fig. 1A), the recipient's name and address 13, postal indicia 14 and indication 79. The scanned information is transferred to accept process images 52. Then the information is sent to encode, sort, store 53. At this point, the recipient's physical address is verified by checking postal address database 54 and the recipient's e-mail address is determined from e-mail database 55. Temporary database 56 is then searched to determine whether or not the recipient has left any forwarding addresses. Encode, sort, store 53 then encodes and sorts the information obtained from databases 54, 55 and 56.

The aforementioned encoded and sorted information is stored in mail image database + archive 57. Then the mail image information is sent to manage mail image DB 58 where the various options and the costs associated therewith that the recipient may have for delivering the information contained in the letter mail is determined. Then the mail images and options that the recipient has for receiving the letter mail from manage mail DB 58 and mailpiece image store and forward 99 (Fig. 5) is sent to send user images 59. The information appearing on the face of the letter mail in alphanumeric and graphic form and the options in alphanumeric and graphic form that the recipient has for receiving the letter mail are transmitted to receiving device 36 (personal computer, television, facsimile machine, personal data assistant, etc.), which is located at the recipient's business or household 35. The options that the recipient has for diverting the letter mail is described in the description of Fig. 4. If the sender

placed an indication 79 or 80 on the mailpiece, the post will deliver the mailpiece in the manner selected by the mailer and not divert the mailpiece.

The recipient may use device 36 (personal computer, facsimile machine, personal data assistant, etc.) located at the recipient's business or household 35 to inform, receive, and process user options 61, located at data center 34, of the manner in which the letter mail should be delivered. The recipient may also use a touch tone and/or voice telephone 87 to inform receive & process user options 61 of the manner in which the recipient would like the letter mail displayed on the receiving device 36, e.g., television delivered. It would be obvious to one skilled in the art that additional communication devices may be used by the recipient to communicate with the carrier. For instance, the recipient may want the letter mail physically delivered to the recipient's house faster or slower, or the letter mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the post open the letter mail and have the post e-mail or fax the contents of the letter mail to the recipient and/or parties designated by the recipient. If the sender placed a indication 79 or 80 on the mailpiece, the post will deliver the mailpiece in the manner selected by the mailer and not divert the mailpiece.

At this juncture the recipient may inform receive & process user options 61 via a device 36 of the manner in which the recipient would like the letter mail processed. Options 61 will then inform the recipient via device 36 of the cost to the recipient to process the letter mail in the manner selected by the recipient. The recipient may then inform the post to deliver the letter mail in the manner selected by the recipient. The recipient's selected manner of letter mail processing is forwarded to options rerouting controller 62. If the post-specified time to deliver the letter mail has not been reached, the letter mail is sent to recipient options 64 and delivered in the manner selected by the recipient in optional diversion processes 65. Then optional diversion process 65 informs manage mail db 58 to archive the image and also to notify bill sender and pay carriers 66 to bill the recipient and pay the post. At this point, the next letter mail image is ready to be processed.

The letter mail may then be delivered to the recipient at mail box 37 at a faster or slower rate than that selected by the sender; held by the post for a specified amount of time and then delivered to a address specified by the recipient; opened, and the contents of the letter mail faxed to recipient-selected fax numbers; opened, and the contents of the letter mail faxed to recipient-selected fax numbers, and then the letter mail may be delivered to the physical address specified by the recipient; opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses; or opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses, and then the letter mail may be delivered to the physical address specified by the recipient. The recipient may also have instructed the post to return the mail to the sender, to destroy the mail, or to recycle the paper in the letter mail. Receive & process user options 61 will also send the cost of the recipient-selected manner of delivery to bill user & pay post/couriers 66 so that the post may debit the recipients account or send a bill to the recipient.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether or not claim 1, is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

B. Whether or not claim 2 is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

C. Whether or not claim 3 is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

D. Whether or not claim 4 is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

E. Whether or not claim 5 is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

F. Whether or not claim 6 is patentable under 35 USC §103(a) over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,825,865).

VII. ARGUMENTS

A. Claim 1 has been rejected by the Examiner under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander et al. (U.S. Patent No. 5,737,729). The inventor of U.S., Patent No. 5,737,729 is Denman, not Oberlander.

Appellants are of the opinion that the Examiner intended to cite U.S. Oberlander's U.S. Patent No. 5,825,865. Thus, Appellants will comment on U.S. Patent No. 5,825,865 as the Oberlander patent).

Hilt discloses the following in lines 58-67 of column 8:

"Turning now to FIG. 4, illustrated is a method of generating an e-mail address carried out according to the principles of the present invention and within the network of FIG. 1 or the computer system of FIG. 2. The method, generally designated 400, begins in a start step 410, when a user wishes to generate an e-mail address.

In a step 420, the user is prompted to provide information regarding an intended recipient. Once the user submits this information, the information may be tested in an optional decisional step 430 for sufficiency. Next, in an optional decisional step 440, the information may be tested for accuracy or existence, perhaps with reference to a database of physical mailing address. If the information is insufficient or inaccurate, or refers to a nonexistent physical address, the user is prompted to completed or correct the information (returning to the step 420).

Hilt discloses the following in lines 49-56 of column 12:

"Assuming the sender is registered, processing continues to a step 725, wherein physical mailing address data are extracted from the e-mail message. Next, in an optional decisional step 735, the physical mailing address of the recipient is derived from the 2-mail address and checked against a database of valid physical addresses. If the physical mailing address is invalid, the sender may be so notified in a step 745."

In the above, Hilt is not depositing physical mail with a carrier.

Hilt discloses the following in lines 24-45 of column 11:

"Another option is to embed both the sender's and the recipient's physical mailing addresses in the recipient's e-mail address, thereby creating an e-mail address that is sender-dependent. While this again works well for

purposes of creating a fully addressed piece of physical mail, e-mail capable recipients would still be hampered in their efforts to reply electronically. Furthermore, a recipient would no longer have a "universal" address; he would instead have a different address for each sender.

Yet another option is to place the sender's return address, encoded or otherwise in some specially defined field in the header of the e-mail message. While possible and perhaps even advantageous, this requires the e-mail message to be formed different than it otherwise would were the recipients all to be e-mail capable. Thus, it may be disadvantageous.

Still another option, and perhaps the one preferred at this time, is to require the sender to supply his physical return address separately (perhaps by separate e-mail message or a visit to a web site. Once supplied, the sender's physical return address can be associated with his regular e-mail address, retrieved from a database and printed whenever an e-mail message bearing the sender's e-mail address is to be converted to physical form."

In the above, Hilt obtains the sender's and the recipient's physical mailing address in an e-mail address. Hilt does not capture the name and physical address of the recipient and the sender from physical mail.

Hilt discloses the following in lines 10-34 of column 6:

"The recipient information receiver 310 may gather such information by presenting one or more data fields that serve to prompt a user to provide such information in a structured manner. In the specific example given in FIG. 3, the recipient information receiver 310 presents a first name field 331, a middle initial field 332, a last name field 333, address fields 334, 335, a city field 336, a state field 337, a ZIP+4 field 338 and a telephone number field 339. Of course, the recipient information receiver 310 may present fewer, more or different fields than these, as a particular application may find advantageous.

Thus presented with these fields 331, 332, 333, 334, 335, 336, 337, 338, 339, the user begins to provide information. When the user believes that he has provided as much information concerning the intended recipient as he can, he can indicate so by submitting the information to the recipient information receiver in a conventional manner (such as by clicking an appropriate button or pressing an "enter" key).

The recipient information receiver 310 then tests the information to determine whether the information is correct or sufficient to generate an e-mail address. If not, the recipient information receiver 310 prompts the

user to supply correct or more information. If not, the recipient information receiver 310 passes the information to the e-mail address generator 320.

Hilt discloses the following in lines 50-60 of column 7:

In one embodiment of the present invention, an e-mail client interface then prompts the user to add at least a portion of the information regarding the intended recipient and the e-mail address to the user's address book (commonly associated with an e-mail client). Alternatively, the e-mail client interface may automatically add at least the portion of the information and the e-mail address to the address book.

It should be apparent that the above e-mail address is but one example taken from a myriad of other possibilities. Some of the other possibilities will now be set forth.

The example calls for the intended recipient's first and last names to form part of the generated e-mail address, because it is desirable that the user be able to determine the intended recipient to whom the e-mail address belongs. Assuming a desire to include some portion of the intended recipient's name, the e-mail address generator 320 may use the intended recipient's first initial and last name, viz.

In the above, Hilt is not notifying the recipient of the availability of the deposited physical mail.

Hilt discloses the following in lines 49-64 of column 12:

"Assuming the sender is registered, processing continues to a step 725, wherein physical mailing address data are extracted from the e-mail message. Next, in an optional decisional step 735, the physical mailing address of the recipient is derived from the e-mail address and checked against a database of valid physical addresses. If the physical mailing address is invalid, the sender may be so notified in a step 745.

If the physical mailing address is valid, the e-mail message may be tested to determine whether it complies with policy. As set forth above with respect to FIG. 6, the e-mail message may be tested to determine whether it includes prohibited content, is too long, violates message page or volume limits or the like. If the e-mail message violates policy, the sender may be so notified (the step 745).

In the above, Hilt is not notifying the sender of the manner in which the recipient would like physical mail delivered, or notifying the carrier that the sender does not elect to have the deposited physical mail diverted.

Oberlander discloses the following in line 35 of column 4 to line 26 of column 5:

"If desired, an input unit (206) can also be optionally provided to allow a user to at least partially configure and determine the message descriptor. This input (206) could comprise, for example, a keyboard that would allow a user to specify at least certain aspects of the message descriptor. In other embodiments, the message descriptor would be automatically structured using predetermined or otherwise automatically determined information.

So configured, the source (102) will transmit a message in combination with a message descriptor. Referring now to FIG. 3, the message descriptor (300) includes many information fields. In this particular embodiment, these fields include a target address (TA) (301) (representing a physical address, such as a telephone number, of a particular recipient destination, a source address (SA) (302) (this being the physical address for the source itself), a target logical ID (TID) (303) (this being a logical ID, such as a personal identification number, that identifies a particular recipient, as versus a particular recipient destination; this information will not always be known, and often this particular field may include a null indicator), a source logical ID (SID) (304) (the source counterpart to the target logical ID), a data type indicator (D TYPE) (305) (to identify the particular kind of message being sent, such as an analog voice message, a voice message that has been vocoded in accordance with a particular vocoding algorithm and method, a facsimile transmission, and so forth), and a format indicator (306) (to identify a particular data format as corresponds to the appended message). The message descriptor (300) further includes a services pointer (307) (to indicate one or more value-added operations to be performed prior to delivery of the message to the recipient; for example, storing and later forwarding the message, converting the message from one format to another, using the message itself as input to the user's profile, defining an action item for subsequent messages, and so forth), a priority indicator (P) (308) (to indicate a particular user defined or automatically attributed priority level to categorize either the importance of the message and/or the sender), a time indicia (309) (to indicate, for example, desired reception time or a deadline by when transmission must be accomplished), and a context header (310) (to include user specified context information pertaining to the message, such as "emergency" or "your loan application").

The message (311) then follows the message descriptor (300). Other categories of information could of course be included in the message descriptor to accommodate the needs of a particular application.

The profile information stored in the profile data base (106) as described above with respect to FIG. 1 is generally depicted in FIG. 4 by reference numeral 400. In this embodiment, each recipient, which recipient may have a plurality of potential message destinations associated therewith, has a corresponding identifying personal identification number (401). For example, one recipient may have personal identification number 1 associated therewith. The information profile next includes the physical addresses (402) associated with that particular recipient. For example, a particular user might have 9 different physical addresses associated with 9 different message destinations, as follows:

In the above, Oberlander does not disclose delivering physical mail to the recipient in the manner specified by the recipient to the carrier.

Neither Hilt nor Oberlander, taken separately or together, discloses the invention claimed by Appellants in claim 1, and those claims dependent thereon. Hilt and Oberlander do not disclose anything about delivering physical mail. Thus, the references do not disclose or anticipate the following steps of claim 1, namely, depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address; notifying the recipient of the availability of the deposited physical mail; notifying the carrier of the manner in which the recipient would like the physical mail delivered; notifying the carrier that the sender does not elect the deposited physical mail to be diverted; capturing the name and physical address of the recipient and the sender from the physical mail; and delivering physical mail to the recipient in the manner specified by the recipient. Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51

F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); in re Fritch, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai, supra;* *in re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); in re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); in re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).*

B. Claim 2 has been rejected by the Examiner under 35 U.S.C. 103(a) under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander.

Claim 2 depends on claim 1, and includes the added step of: the sender placing an indication on the physical mail specifying that the physical mail should not be diverted by the recipient.

The Examiner stated on Page 4 of the Final Rejection the following: "As per claim 2, Hilt-Oberlander disclose the sender places an indication on the mail specifying that the mail should not be diverted by the recipient [Hilt, the call server request connection service eliminated the need for switch to execute a state machine to check for service logic trigger, co. 6, lines 51-65].

Oberlander discloses the following in column 6, lines 44-60.

"Accordingly, messages (and/or message descriptors) that include a particular recipient alias are directed to an appropriate recipient preferred corresponding destination. For example, messages intended for "Felix Esquire" or "Cat Enterprises" are particularly desired by this recipient for receipt at either address 1 or address 5 (these being the recipient's office telephone and office facsimile machine, respectively). Messages directed, however, to "Ignatz" or "Nine Lives Insurance" are steered instead to either the recipient's home telephone or facsimile machine. It will be further noted that the alias "Nine Lives Insurance" as set forth for address 2 and address 6, and the alias "Litterman" as specified for address 8, have an asterisk associated therewith. The asterisk specifies an indicia of exclusivity. Accordingly, messages that specify "Nine Lives Insurance" can only be steered to either address 2 of 6. The recipient has indicated a particular sensitivity towards reception of such messages, and has accordingly indicated a refusal to receive such messages at any other destination."

In addition to the arguments made in above Section A, Oberlander is concerned about the recipient's sensitivities, regarding diverting non physical mail. Whereas Oberlander teaches away from the recipient in that Appellant claims a method in which the sender places an indication on the physical mail specifying that the physical mail should not be diverted by the recipient. An advantage of the foregoing is that the sender may want to make sure that the recipient can not divert the sending of the physical mail to a different address; e.g., the physical mail may contain legal documents that the recipient does not want to receive; i.e., a summons and complaint, notice of patent infringement, etc..

C. Claim 3 has been rejected by the Examiner under 35 U.S.C. 103(a) under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander.

Claim 3 depends on claim 1, and includes the additional step of: charging the sender for placing an indication on the physical mail specifying that the physical mail should not be diverted by the recipient.

The Examiner stated on Page 4 of the Final Rejection the following: "As per claim 3, Hilt-Oberlander disclose charging the sender for placing an indication on the mail specifying that the mail should not be diverted by the recipient [Oberlander, user optionally allow to specify the message descriptor, col 4 lines 35-col 5 line 26].

Oberlander discloses the following in column 4, line 35 to col 5 line 26.

"If desired, an input **(206)** can also be optionally provided to allow a user to at least partially configure and determine the message descriptor. This input **(206)** could comprise, for example, a keyboard that would allow a user to specify at least certain aspects of the message descriptor. In other embodiments, the message descriptor would be automatically structured using predetermined or otherwise automatically determined information.

So configured, the source **(102)** will transmit a message in combination with a message descriptor. Referring now to **FIG. 3**, the message descriptor **(300)** includes many information fields. In this particular embodiment, these fields include a target address (TA) **(301)** (representing a physical address, such as a telephone number, of a particular recipient destination), a source address (SA) **(302)** (this being the physical address for the source itself), a target logical ID (TID) **(303)**

(this being a logical ID, such as a personal identification number, that identifies a particular recipient, as versus a particular recipient destination; this information will not always be known, and often this particular field may include a null indicator), a source logical ID (SID) **(304)** (the source counterpart to the target logical ID), a data type indicator (D TYPE) **(305)** (to identify the particular kind of message being sent, such as an analog voice message, a voice message that has been vocoded in accordance with a particular vocoding algorithm and method, a facsimile transmission, and so forth), and a format indicator **(306)** (to identify a particular data format as corresponds to the appended message). The message descriptor **(300)** further includes a services pointer **(307)** (to indicate one or more value-added operations to be performed prior to delivery of the message to the recipient; for example, storing and later forwarding the message, converting the message from one format to another, using the message itself as input to the user's profile, defining an action item for subsequent messages, and so forth), a priority indicator (P) **(308)** (to indicate a particular user defined or automatically attributed priority level to categorize either the importance of the message and/or the sender), a time indicia **(309)** (to indicate, for example, desired reception time or a deadline by when transmission must be accomplished), and a context header **(310)** (to include user specified context information pertaining to the message, such as "emergency" or "your loan application").

The message **(311)** then follows the message descriptor **(300)**. Other categories of information could of course be included in the message descriptor to accommodate the needs of a particular application.

The profile information stored in the profile data base **(106)** as described above with respect to **FIG. 1** is generally depicted in **FIG. 4** by reference numeral **400**. In this embodiment, each recipient, which recipient may have a plurality of potential message destinations associated therewith, has a corresponding identifying personal identification number **(401)**. For example, one recipient may have personal identification number 1 associated therewith. The information profile next includes the physical addresses **(402)** associated with that particular recipient. For example, a particular user might have 9 different physical addresses associated with 9 different message destinations, as follows:"

In addition to the arguments made in above Section A, the art cited by the Examiner does not disclose or anticipate a method in which the sender is charged for the placing of an indication on physical mail specifying that the recipient should not divert the physical mail.

D. Claim 4 has been rejected by the Examiner under 35 U.S.C. 103(a) under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander.

Claim 4 depends on claim 1, and includes the additional step of: charging the sender for placing an indication on the physical mail specifying that the physical mail should not be diverted by the recipient.

The Examiner stated on Page 4 of the Final Rejection the following. "As per claim 4, Hilt-Oberlander disclose the sender places an indication on the mail specifying that the mail should be delivered only as specified by the sender [Oberlander, user optionally allow to specify the message descriptor, col 4 lines 35-col 5 line 26].

Oberlander discloses the following in column 4, line 35 to col 5 line 26.

"If desired, an input **(206)** can also be optionally provided to allow a user to at least partially configure and determine the message descriptor. This input **(206)** could comprise, for example, a keyboard that would allow a user to specify at least certain aspects of the message descriptor. In other embodiments, the message descriptor would be automatically structured using predetermined or otherwise automatically determined information.

So configured, the source **(102)** will transmit a message in combination with a message descriptor. Referring now to **FIG. 3**, the message descriptor **(300)** includes many information fields. In this particular embodiment, these fields include a target address(TA) **(301)** (representing a physical address, such as a telephone number, of a particular recipient destination), a source address (SA) **(302)** (this being the physical address for the source itself), a target logical ID (TID) **(303)** (this being a logical ID, such as a personal identification number, that identifies a particular recipient, as versus a particular recipient destination; this information will not always be known, and often this particular field may include a null indicator), a source logical ID (DIS) **(304)** (the source counterpart to the target logical ID), a data type indicator (D TYPE) **(305)** (to identify the particular kind of message being sent, such as an analog voice message, a voice message that has been vocoded in accordance with a particular vocoding algorithm and method, a facsimile transmission, and so forth), and a format indicator **(306)** to identify a particular data format as corresponds to the appended message). The message descriptor **(300)** further includes a services pointer **(307)** (to indicate one or more value-added operations to be performed prior to delivery of the message to the recipient; for example, storing and later forwarding the message, converting the message from one format to another, using the message itself as input to the user's profile, defining an action item for subsequent

messages, and so forth), a priority indicator (P) (308) (to indicate a particular user defined or automatically attributed priority level to categorize either the importance of the message and/or the sender), a time indicia (309) (to indicate, for example, desired reception time or a deadline by when transmission must be accomplished), and a context header (310) (to include user specified context information pertaining to the message, such as "emergency" or "your loan application").

The message (311) then follows the message descriptor (300). Other categories of information could of course be included in the message descriptor to accommodate the needs of a particular application.

The profile information stored in the profile data base (106) as described above with respect to FIG. 1 is generally depicted in FIG. 4 by reference numeral 400. In this embodiment, each recipient, which recipient may have a plurality of potential message destinations associated therewith, has a corresponding identifying personal identification number (401). For example, one recipient may have personal identification number 1 associated therewith. The information profile next includes the physical addresses (402) associated with that particular recipient. For example, a particular user might have 9 different physical addresses associated with 9 different message destinations, as follows:"

In addition to the arguments made in above Section A, the art cited by the Examiner does not disclose or anticipate a method in which the sender is charged for the placing of an indication on physical mail specifying that the recipient should not divert the physical mail.

E. Claim 5 has been rejected by the Examiner under 35 U.S.C. 103(a) under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander.

Claim 5 depends on claim 1, and includes the additional step of: charging the sender for placing an indication on the physical mail specifying that the physical mail should be delivered only as specified by the sender. The Examiner stated on Pages 4 and 5 of the Final Rejection the following: "As per claim 5, Hilt-Oberlander disclose charging the sender for placing an indication on the mail specifying that the mail should be delivered only as specified by the sender [Oberlander, a priority indicator indicate a particular user/sender defined, col 5 lines 1-10].

Oberlander discloses the following in column 4, line 63 to col 5 line 11.

"The message descriptor **(300)** further includes a services pointer **(307)** (to indicate one or more value-added operations to be performed prior to delivery of the message to the recipient; for example, storing and later forwarding the message, converting the message from one format to another, using the message itself as input to the user's profile, defining an action item for subsequent messages, and so forth), a priority indicator (P) **(308)** (to indicate a particular user defined or automatically attributed priority level to categorize either the importance of the message and/or the sender), a time indicia **(309)** (to indicate, for example, desired reception time or a deadline by when transmission must be accomplished), and a context header **(310)** (to include user specified context information pertaining to the message, such as "emergency" or "your loan application").

In addition to the arguments made in above Section A, the art cited by the Examiner does not disclose or anticipate a method in which the sender is charged for the placing of an indication on physical mail specifying that the physical mail should be delivered only as specified by the sender.

F. Claim 6 has been rejected by the Examiner under 35 U.S.C. 103(a) under 35 U.S.C. 103(a) as being obvious over Hilt (U.S. Patent No. 6,604,132B1) in view of Oberlander.

Claim 6 depends on claim 1, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the physical mail delivered.

The Examiner stated on Page 5 of the Final Rejection the following: "As per claim 6, Hilt-Oberlander disclose the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered [Hilt, the sender may be notified, col 12 lines 49-64].

Hilt discloses the following in column 12, lines 49-64.

"Assuming the sender is registered, processing continues to a step **725**, wherein physical mailing address data are extracted from the e-mail message. Next, in an optional decisional step **735**, the physical mailing address of the recipient is derived from the e-mail address and checked against a database of valid physical addresses. If the physical mailing address is invalid, the sender may be so notified in a step **745**.

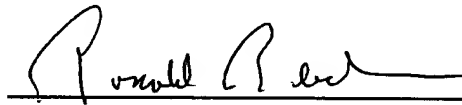
If the physical mailing address is valid, the e-mail message may be tested to determine whether it complies with policy. As set forth above with respect to **FIG. 6**, the e-mail message may be tested to determine whether it includes prohibited content, is too long, violates message page or volume limits or the like. If the e-mail message violates policy, the sender may be so notified (the step **745**).

In addition to the arguments made in above Section A, the art cited by the Examiner does not disclose or anticipate a method in which the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the physical mail delivered.

VIII PRAYER FOR RELIEF

Appellants respectfully submit that appealed claims 1-6 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Ronald Reichman", is written over a horizontal line.

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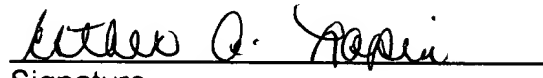
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IX.

Appendix A

Claims -

1. A method that enables a recipient to inform a carrier of the manner in which the recipient would like the mail delivered, said method comprises the steps of:

depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address;

capturing the name and physical address of the recipient and the sender from the physical mail;

translating the name and physical address of the recipient into an e-mail address;

notifying the recipient of the availability of the deposited physical mail;

notifying the carrier of the manner in which the recipient would like the physical mail delivered;

notifying the carrier that the sender does not elect the deposited physical mail to be diverted; and

delivering physical mail to the recipient in the manner specified by the recipient to the carrier, if the sender elects to permit the recipient to divert the physical mail.

2. The method claimed in claim 1, wherein the sender places an indication on the physical mail specifying that the physical mail should not be diverted by the recipient.

3. The method claimed in claim 2, further including the step of:

charging the sender for placing an indication on the physical mail specifying that the physical mail should not be diverted by the recipient.

4. The method claimed in claim 1, wherein the sender places an indication on the physical mail specifying that the physical mail should be delivered only as specified by the sender.

5. The method claimed in claim 4, further including the step of:
charging the sender for placing an indication on the physical mail specifying that the physical mail should be delivered only as specified by the sender.
6. The method claimed in claim 1, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the physical mail delivered.